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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/708,919	03/31/2004	Mark C. Boomer	101896-0241	2918

21125 7590 04/04/2007
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EXAMINER

COMSTOCK, DAVID C

ART UNIT	PAPER NUMBER
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3733

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/04/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/708,919

Applicant(s)

BOOMER ET AL.

Examiner

David Comstock

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,7-10,13-20,42,43 and 46-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,7-10,13-20,42,43 and 46-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 13-20, 42, 43, 46, 48 and 49 are rejected under 35 U.S.C. 102(b) as being anticipated by Lai (5,509,328).

Lai discloses a device comprising a first elongate member 10 having a female connector with opposed arms 13 and a second elongate member 20 having a male connector 40 adapted to mate to the female connector (see Fig 2). The members are adjustably coupled to one another. A fastening element locks the elongate members in a fixed position. The devices are angularly adjustable in a single plane. The opposed arms define a recess for receiving the male connector. The device includes a bore 14 extending through the opposed arms on the female connector and through the male connector, and a central mating element 51,52 extending through the bore for mating the male and female connectors together. The central mating element comprises a cylindrical member 51. The device rotates about this member when it is in a loosened state. The cylindrical member is fixedly coupled to a portion of the female connector, and the male connector is free to rotate about the cylindrical member when loose. The fastening element is effective to engage the cylindrical member to prevent movement of

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the male connector relative to the female connector when tightened. The fastening element comprises a slot 43 extending through the male connector such that the male connector is in the form of a clamp, and wherein the device further comprises a threaded fastener 44 adapted to engage and mate with the male connector to clamp the cylindrical member within the bore. The female connector and male connector rotate about a central axis extending substantially perpendicular to an axis of the first and second elongate members. The fastening element is adapted to extend into a connector along an axis that is substantially parallel to the plane of adjustability. The diameter of the first and second elongate member appears to be substantially the same. A terminal end of the second elongate member is at an angle to a longitudinal axis of the second elongate member.

Claims 1, 2, 7, 9, 13-16, 20, 42 and 43 are rejected under 35 U.S.C. 102(b) as being anticipated by Yue (6,007,536).

Yue discloses a device comprising a rod 1 that can be fixed at an angle with respect to a plate 2 by means of a fastening element 4 (see Figs. 1A-1C). The device adjusts in a single plane. The plate includes a female connector having arms that receive a male connector (see Fig. 1B). A bore extends through the male and female connector components to allow rotation about a cylindrical mating element attached to the female connector. The fastening element is mated with the female connector. Both the plate and rod are capable of being implanted and used for spinal applications.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8, 10, 47 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yue (6,007,536).

With regard to claim 8, Yue discloses the claimed invention except for disclosing that the device could be comprised of rods (or plates) instead of one rod and one plate. However, given the disclosure of both a rod and a plate, it would have been obvious to a person of ordinary skill in the art, to have configured the device with two rods (or plates) instead of one rod and one plate, in order to address the exigencies of surgical necessity or patient anatomy.

With regard to claims 10, 47 and 50, Yue discloses the claimed invention except for explicitly disclosing different diameters or an offset angle of 90 degrees. It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the device with differing diameters or with an offset angle of 90 degrees, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Response to Arguments

In response to applicant's argument that Lai is not a "spinal fixation rod", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it anticipates the claim. In the instant case, that the structure of the device of Lai meets the claim limitations, as set forth above, and is rigid, is a sufficient indication that the device could be used to provide a support means for a spinal column if it were so desired. The functionality need not be optimal, but rather, the device must merely at least be capable of performing the intended use. It is noted that spinal fixation rods are not always "implanted *in* the spine" as asserted by Applicant. Instead, and more frequently, in fact, they are fastened outside of the spinal column and secondary fasteners such as bone screws, pins or clamps secure the rod to the column itself. Thus, the argument that Lai discloses a "handlebar tube" does not make it unsuitable for the intended use. Moreover, it could be implanted in an animal species if desired as it is nothing more than a rigid metal support. With respect to Yue, it is maintained that the fastening element is mated with the female connector as set forth in the rejection and as can be seen in, for example, figures 1A-1C.

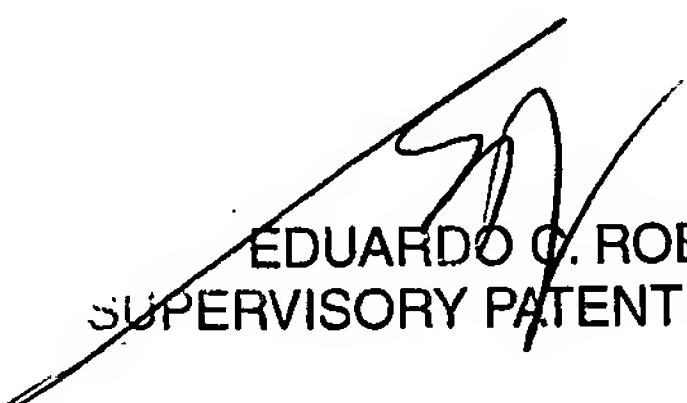
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Comstock whose telephone number is (571) 272-4710. Please leave a detailed voice message if examiner is unavailable. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



D. Comstock



EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER